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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,926

02/07/2005

Jan van Walraven

WALRAVEN3

1885

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EXAMINER

DUMAS, NKEISHA J

ART UNIT

PAPER NUMBER

3632

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,926	Applicant(s) VAN WALRAVEN, JAN	
	Examiner NKEISHA J. DUMAS	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The following correspondence is an Office Action for application number 10/523,926, for a VIBRATION ISOLATING PIPE CLIP, filed on 2/7/2005. This correspondence is in response to applicant's reply filed on 1/18/2008. Claims 53-58 are pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 56 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 56 recites the limitation "the form fact" in the sixth line therein. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 54-56 and 58 is rejected under 35 U.S.C. 102(b) as being anticipated Van Walraven (EP 1,106,900 A1).

Regarding claims 54 and 55, Van Walraven teaches a vibration isolating pipe clip (1) comprising a rigid pipe clip body (2, 3) which is composed of one or more parts and

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is provided with securing means (7); a vibration isolating member (10) which bears against an inner circumference of the pipe clip body and is ultimately positioned between an outer circumference of the pipe and the pipe clip body (Fig. 1), wherein the vibration isolating member (13) is a porous vulcanized rubber with closed cavities and separating walls between them [0008, 0025] having a chemical (from the vulcanization process, which includes a chemical reaction). The Examiner notes that the term “vulcanized” recited in the claim relates to a method of making the rubber. Where a method step is recited in an article claim, only the article recited by the method is considered. Therefore, it is unnecessary to find the method of vulcanization, or the steps inherently performed therein, in order to determine the final rubber product, and therefore, only the rubber product made from the method is considered. In addition the phrases “by dehydration of salt which remains in the cavities” and “from which water has been cleaved” relate to a method of making the rubber during the vulcanization process. Again, where a method step is recited in an article claim, only the article recited by the method is considered. Therefore, it is unnecessary to find the method in order to determine the final rubber product, and therefore, only the rubber product made from the method is considered.

Although claim 56 contains purely functional limitations, it is nonetheless rejected because Van Walraven teaches a vibration isolating member that has a form factor defined by the quotient of the surface area which is subject to load and the free surface area, and in which the cavities significantly reduce the form factor.

Regarding claim 58, Van Walraven teaches a vibration isolating pipe clip (1) comprising a rigid pipe clip body (2, 3) which is composed of one or more parts and is provided with securing means (7); a vibration isolating member (10) which bears against an inner circumference of the pipe clip body and is ultimately positioned between an outer circumference of the pipe and the pipe clip body (Fig. 1), wherein the vibration isolating member (13) is a porous vulcanized rubber with closed cavities and separating walls between them [0008, 0025], wherein the cavities are substantially unpressurized, in such a manner that in the event of a reduction in the volume of the cavities under the influence of deformation of the vibration isolating member, no significant pressure occurs inside the cavities [0025, 0032]. The Examiner notes that the term “vulcanized” recited in the claim relates to a method of making the rubber. Where a method step is recited in an article claim, only the article recited by the method is considered. Therefore, it is unnecessary to find the method of vulcanization, or the steps inherently performed therein, in order to determine the final rubber product, and therefore, only the rubber product made from the method is considered. In addition the phrase “by dehydration of salt which remains in the cavities” relates to a method of making the rubber during the vulcanization process. Again, where a method step is recited in an article claim, only the article recited by the method is considered. Therefore, it is unnecessary to find the method in order to determine the final rubber product, and therefore, only the rubber product made from the method is considered.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 53 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Walraven (EP 1,106,900 A1).

Regarding claim 53, Van Walraven teaches a vibration isolating pipe clip (1) comprising a rigid pipe clip body (2, 3) which is composed of one or more parts and is provided with securing means (7); a vibration isolating member (10) which bears against an inner circumference of the pipe clip body and is ultimately positioned between an outer circumference of the pipe and the pipe clip body (Fig. 1), wherein the vibration isolating member (13) is a porous vulcanized rubber with closed cavities and separating walls between them [0008, 0025], wherein the cavities are substantially unpressurized, in such a manner that in the event of a reduction in the volume of the cavities under the influence of deformation of the vibration isolating member, no significant pressure occurs inside the cavities [0025, 0032], wherein the vibration isolating member has a form factor defined by the quotient of the surface area which is subject to load and the free surface area, and in which the cavities significantly reduce the form factor, but does not teach that the form factor of the isolating member is less than 0.2. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make the vibration isolating member of the pipe clip with a form factor of less than 0.2

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since the discovery of an optimum value of a result effective variable involves only routine skill in the art. The Examiner notes that the term “vulcanized” recited in the claim relates to a method of making the rubber. Where a method step is recited in an article claim, only the article recited by the method is considered. Therefore, it is unnecessary to find the method of vulcanization, or the steps inherently performed therein, in order to determine the final rubber product, and therefore, only the rubber product made from the method is considered. In addition the phrase “by dehydration of salt which remains in the cavities” relates to a method of making the rubber during the vulcanization process. Again, where a method step is recited in an article claim, only the article recited by the method is considered. Therefore, it is unnecessary to find the method in order to determine the final rubber product, and therefore, only the rubber product made from the method is considered.

Regarding claim 57, Van Walraven teaches the clip of claim 56, but does not teach that the form factor of the isolating member is less than 0.2. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to make the vibration isolating member of the pipe clip with a form factor of less than 0.2 since the discovery of an optimum value of a result effective variable involves only routine skill in the art.

Response to Arguments

8. Applicant's arguments filed 1/18/2008 have been fully considered but they are not persuasive.

9. Applicant argues that the Van Walraven '900 reference is structurally different from the present invention disclosed in the application because the prior art does not teach a vibration isolating layer having closed cavities with separating walls between them that are substantially unpressurized by dehydration of salt. The examiner respectfully disagrees.

First, applicant has not set forth any distinctive structural characteristics that made the rubbers different from each other. In addition, applicant has not produced any evidence or empirical data supporting this position or explaining the structural differences.

Second, the examiner agrees with the applicant that the claims presented herein are product-by-process claims, however, the examiner disagrees with the applicant on the application of this type of claim. In a product-by-process claim, the claims are drawn to the particular product, and not the method of manufacturing the product. The references to the process by which the product is constructed is only a means for describing or defining the product. Therefore, only the finished product, or article, is considered. Thus, as long as the prior art teaches the finished product, then it is unnecessary to find the steps involved in the method of manufacturing the product.

Third, as explained by the applicant, the method of the dehydration of salt occurs during the process of the vulcanization of the rubber. The process of vulcanization is the method by which rubber is created, thus the teaching of vulcanized rubber is not a new concept in the art. Any process which involves dehydrating salt during the vulcanization process is inherent in the formation of rubber itself.

Next, applicant appears to argue that the only manner of having cavities that are substantially unpressurized is by dehydration of salt. The examiner respectfully disagrees. The Van Walraven prior art reference teaches a porous closed cell rubber material that is inherently "substantially unpressurized". These cavities of the vibration isolating member are inherently unpressurized in that once the walls of the cells are deformed under the influence of vibrations in the pipe, the walls will experience a pressure decrease when some of the atmospheric pressure that once occupied that area will be released in order to absorb the load. Thus, when the material is compressed, the volume of the material is reduced. [00008] This indicates that the material inherently is substantially unpressurized because it is able to deform when compressed. If the converse was true, and the material was in fact pressurized, then it would not be able to deform. But that is not the case.

Finally, the statement regarding the substantial unpressurization of the cavities "in such a manner that in the event of a reduction in the volume of the cavities" is a functional limitation that relates to the use of the material and its behavior when subject to compression. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As indicated above, Van Walraven teaches a material that is capable of behaving "in such a manner that in the event of a reduction in the volume of the cavities under the influence of deformation

of the vibration isolating member, no significant pressure occurs inside the cavities” simply by virtue of the elastic nature of the material.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NKEISHA J. DUMAS whose telephone number is (571)272-5781. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anita M. King/
Primary Examiner, Art Unit 3632

/N. J. D./
Examiner, Art Unit 3632
April 11, 2008